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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/814,536

03/30/2004

Jonathan J. Hull

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08/08/2006

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EXAMINER

SINGH, SATWANT K

ART UNIT

PAPER NUMBER

2625

DATE MAILED: 08/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/814,536

Applicant(s)

HULL ET AL.

Examiner

Satwant K. Singh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>3/31/04, 12/27/04, 10/31/05, 4/17/06</u>                                  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Response to Amendment***

1. This office action is filed in response to the amendment filed on 5 May 2006.

### ***Response to Arguments***

2. Applicant's arguments, see amendment, filed 5 May 2006, with respect to the rejection(s) of claim(s) 1 under § 120 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Reber et al. (US 6,138,151).

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-3, 9-12, 16, 18-28, 30, 31, and 40 are rejected under 35 U.S.C. 102(e) as being anticipated by Reber et al (US 6,138,151).
5. Regarding Claim 1, Reber et al disclose a method, comprising: receiving, by a printer, a document having a pointer pointing to data that is not in the received document (publisher terminal 62 communicates the electronic

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addresses to the node 46, computer generates a plurality of codes, one for each electronic address); and creating by the printer, in response to receipt of the document, a printable document in accordance with the pointer (publisher prints the publication 12 associating the codes with the articles using a printing device) (col. 6, lines 16-30).

6. Regarding Claim 2, Reber et al disclose a method, further including retrieving the data pointed to by the pointer and including the retrieved data in the printable document pointer (publisher prints the publication 12 associating the codes with the articles using a printing device) (col. 6, lines 16-30).

7. Regarding Claim 3, Reber et al disclose a method, further including storing, by the printer in a database, the data pointed to by the pointer (one or more records in the database 54) (col. 5, lines 18-25).

8. Regarding Claim 9, Reber et al disclose a method, wherein the pointer is a World Wide Web pointer (electronic address is a URL) (col. 5, lines 25-44).

9. Regarding Claim 10, Reber et al disclose a method, wherein the pointer is a URL (electronic address is a URL) (col. 5, lines 25-44).

10. Regarding Claim 11, Reber et al disclose a method, wherein the printable document includes at least one frame grab of video data pointed to by the pointer (examples of data content) (col. 9. lines 13-24).

11. Regarding Claim 12, Reber et al disclose a method, wherein the received document includes commands for the printer to perform a multimedia related action (examples of data content) (col. 9. lines 13-24).

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12. Regarding Claim 16, Reber et al disclose a method, wherein the document is received from a standalone application that processes the document to identify the pointer (articles) (col. 3, lines 48-54).

13. Regarding Claim 18, Reber et al discloses a method, further comprising: printing the printable document (publisher prints the publication 12 associating the codes with the articles using a printing device) (col. 6, lines 16-30); and receiving input in accordance with the document printed by the printer and retrieving multimedia data in accordance with the input (end user 50) (col. 5, lines 57-65).

14. Regarding Claim 19, Reber et al disclose a method, comprising: receiving by a printer a document containing multimedia information (publisher terminal 62 communicates the electronic addresses to the node 46, computer generates a plurality of codes, one for each electronic address); and creating by the printer, in response to receipt of the document, a printable document in accordance with the multimedia information (publisher prints the publication 12 associating the codes with the articles using a printing device) (col. 6, lines 16-30).

15. Regarding Claim 20, Reber et al disclose a method, wherein the multimedia information is video (examples of data content) (col. 9. lines 13-24).

16. Regarding Claim 21, Reber et al disclose a method, wherein the multimedia information is audio (examples of data content) (col. 9. lines 13-24).

17. Regarding Claim 22, Reber et al disclose a method, wherein the multimedia information is animation (examples of data content) (col. 9. lines 13-24).

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18. Regarding Claim 23, Reber et al disclose a method, wherein the multimedia information is a composite document (examples of data content) (col. 9, lines 13-24).

19. Regarding Claim 24, Reber et al disclose a method, wherein the multimedia information points to multimedia content and further comprising retrieving the multimedia content in accordance with the multimedia information (publisher prints the publication 12 associating the codes with the articles using a printing device) (col. 6, lines 16-30).

20. Regarding Claim 25, Reber et al disclose a method, further comprising storing by the printer at least some of the multimedia information in a database (one or more records in the database 54) (col. 5, lines 18-25).

21. Regarding Claim 26, Reber et al disclose a method, further including printing at least a portion of the multimedia information as part of the printable document (publisher prints the publication 12 associating the codes with the articles using a printing device) (col. 6, lines 16-30).

22. Regarding Claim 27, Reber et al disclose a method, further including placing a bar code in the printable document that represents at least some of the multimedia information (printed codes include a barcode) (col. 3, lines 56-64).

23. Regarding Claim 28, Reber et al disclose a method, further including placing a bar code in the printable document that represents a pointer to multimedia content and that further represents at least some of the multimedia content (printed codes include a barcode) (col. 3, lines 56-64).

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24. Regarding Claim 30, Reber et al disclose a method, wherein the multimedia information is a World Wide Web pointer to multimedia information (electronic address is a URL) (col. 5, lines 25-44).

25. Regarding Claim 31, Reber et al disclose a method, wherein the printable document includes at least one frame grab of video data in accordance with the multimedia information (examples of data content) (col. 9, lines 13-24).

26. Regarding Claim 40, Reber et al disclose a printer, comprising: means for receiving, by a printer, a document having a pointer pointing to data that is not in the received document (publisher terminal 62 communicates the electronic addresses to the node 46, computer generates a plurality of codes, one for each electronic address); and means for creating by the printer, in response to receipt of the document, a printable document containing at least a portion of the data pointed to by the pointer (publisher prints the publication 12 associating the codes with the articles using a printing device) (col. 6, lines 16-30).

27. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

28. Claims 32-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Matsubayashi et al (US 6,138,151).

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29. Regarding Claim 32, Matsubayashi et al disclose a method performed by a printer, comprising: gathering information about multimedia data that is accessible to the printer (Fig. 8, browsing for printable documents) (col. 6, lines 14-48); and creating a summary of the accessible multimedia data (Fig. 15) (col. 7, lines 4-8).

30. Regarding Claim 33, Matsubayashi et al disclose a method, further comprising printing the created summary (Fig. 15, print button).

31. Regarding Claim 34, Matsubayashi et al disclose a method, where the printer is connected to a network and can access multimedia data via the network (Fig. 1 internet 12).

32. Regarding Claim 35, Matsubayashi et al disclose a method, where the printer stores multimedia data and the stored data is the data accessible by the printer (Fig. 4, file storage).

33. Regarding Claim 36, Matsubayashi et al disclose a method, where the printer has access to a database containing multimedia data (Fig. 8, retrieve document).

### ***Claim Rejections - 35 USC § 103***

34. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.



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35. Claims 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reber et al in view of Owen (US 7,075,676).

36. Regarding Claim 4, Reber et al fail to teach a method, further including the pointer to the data as part of the printable document, wherein the printable document includes both the data that is not in the retrieved document and the printer.

Owen teaches a method, further including the pointer to the data as part of the printable document, wherein the printable document includes both the data that is not in the retrieved document and the printer (actual information converted to and printed as barcode) (col. 2, lines 55-67).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Reber with the teaching of Owen to encode a portion of the print job.

37. Regarding Claim 5, Reber et al fail to teach a method, further including placing a bar code in the printable document that represents at least some of the data pointed to by the pointer, wherein the printable document includes both the data that is not in the retrieved document and the printer.

Owen teaches a method, further including placing a bar code in the printable document that represents at least some of the data pointed to by the pointer, wherein the printable document includes both the data that is not in the retrieved document and the printer (actual information converted to and printed as barcode) (col. 2, lines 55-67).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Reber with the teaching of Owen to encode a portion of the print job.

38. Regarding Claim 6, Reber et al fail to teach a method, further including placing a bar code in the printable document that represents a local storage location of at least some of the data pointed to by the pointer, wherein the printable document includes both the data that is not in the retrieved document and the printer.

Owen teaches a method, further including placing a bar code in the printable document that represents a local storage location of at least some of the data pointed to by the pointer, wherein the printable document includes both the data that is not in the retrieved document and the printer (actual information converted to and printed as barcode) (col. 2, lines 55-67).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Reber with the teaching of Owen to encode a portion of the print job.

39. Regarding Claim 7, Reber et al fail to teach a method, further including placing a bar code in the printable document that represents the pointer, wherein the printable document includes both the data that is not in the retrieved document and the printer.

Owen teaches a method, further including placing a bar code in the printable document that represents the pointer, wherein the printable document

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includes both the data that is not in the retrieved document and the printer (actual information converted to and printed as barcode) (col. 2, lines 55-67).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Reber with the teaching of Owen to encode a portion of the print job.

40. Claims 8, 13-15, 17, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reber et al in view of Dutta (US 2002/0135800).

41. Regarding Claim 8, Reber et al fail to teach a method, where the received document is a PDL file.

Dutta teaches a method, wherein the received document is a PDL file (page 4, paragraph [0044]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Reber with the teaching of Dutta to allow the printer to be implemented in a variety of software environments.

42. Regarding Claim 13, Reber et al fail to teach a method, wherein the printer analyses the received document to extract the pointer from the document.

Dutta teaches a method, wherein the printer analyses the received document to extract the pointer from the document (Fig. 6, filtering document).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Reber with the teaching of Dutta to parsing the document.

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43. Regarding Claim 14, Reber et al fail to teach a method, wherein the document is received from a print-driver that processes the document to identify the pointer.

Dutta teaches a method, wherein the document is received from a print-driver that processes the document to identify the pointer (Fig. 3, print driver 314) (page 5, paragraph [0053]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Reber with the teaching of Dutta use a print driver to obtain the document and forward that information to the printer.

44. Regarding Claim 15, Reber et al fail to teach a method, wherein the document is received from a plug-in that processes the document to identify the pointer.

Dutta teaches a method, wherein the document is received from a plug-in that processes the document to identify the pointer (Fig. 3, browser plug-in 306) page 5, paragraph [0053]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Reber with the teaching of Dutta use a plug-in to render the document.

45. Regarding Claim 17, Reber et al fail to teach a method, wherein the printer further interacts with a user before printing the document.

46. Dutta teaches a method, wherein the printer further interacts with a user before printing the document (Fig. 3, user interface 322).

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47. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Reber with the teaching of Dutta to let the user select various printing options prior to printing the document.

48. Claim 29 is rejected for the same reason as claim 8.

49. Claims 37-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsubayashi et al in view of Reber et al.

50. Regarding Claim 37, Matsubayashi et al fail to teach a method, wherein the summary includes a representation of audio data.

Reber et al teach a method, wherein the summary includes a representation of audio data (examples of data content) (col. 9. lines 13-24).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Matsubayashi with the teaching of Reber to allow the summary include different types of data.

51. Regarding Claim 38, Matsubayashi et al fail to teach a method, wherein the summary includes a representation of video data.

Reber et al teach a method, wherein the summary includes a representation of video data (examples of data content) (col. 9. lines 13-24).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Matsubayashi with the teaching of Reber to allow the summary include different types of data.

52. Regarding Claim 39, Matsubayashi et al fail to teach a method, wherein the summary includes a representation of graphical data.

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Reber et al teach a method, wherein the summary includes a representation of graphical data (examples of data content) (col. 9. lines 13-24).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Matsubayashi with the teaching of Reber to allow the summary include different types of data.

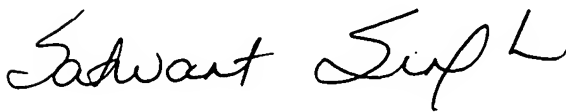
***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Satwant K. Singh whose telephone number is (571) 272-7468. The examiner can normally be reached on Monday thru Friday 8am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A. Williams can be reached on (571) 272-7471. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



sks

Satwant K. Singh  
Examiner  
Art Unit 2625



**KIMBERLY WILLIAMS**  
**SUPERVISORY PATENT EXAMINER**